

Remarks

Amendments to the Claims

Claims 23 and 25 have been cancelled without prejudice.

Claims 14, 16, 21 and 24 have been amended as indicated above.

In particular, claim 14 has been amended to correct an antecedent basis issue regarding the phrase "the print job", and claims 14 and 16 have been respectively amended to expand on (i.e., define) the abbreviation "PML", so to address rejection of those claims under 35 U.S.C. § 112, second paragraph. Support for the amendments to claims 14 and 16 with respect to the abbreviation "PML" can be found at least on page 5, lines 4-7 of the Specification as originally filed.

Claim 21 has been amended to include limitations directed to a message formatted as a print job and including the PML object UI_SELECT_OPTION. Support for the amendment to claim 21 can be found at least on page 2, line 10 to page 5, line 29 of the Specification as originally filed. Claim 24 has been amended to depend from claim 21 (as amended). No new matter has been introduced by the amendments to the claims.

Rejection of Claims under 35 U.S.C. § 112

Claims 14-20 and 25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has asserted that:

- 1) The term "the print job" as used in claim 14 is lacking proper antecedent basis; and
- 2) The abbreviation "PML" as used in claims 14, 16 and 25 is uncertain and should be expanded upon.

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1 In regard to the § 112 rejection of claim 25, that claim has been cancelled as
2 indicated above. Therefore, the § 112 rejection of claim 25 is now moot. In regard
3 to claims 14 and 16, those claims have been respectively amended as indicated
4 above to address the Examiner's grounds for § 112 rejection. As a result, the
5 Applicants respectfully request that the § 112, second paragraph, rejection of claims
6 14-20, as respectively amended, be withdrawn.

7

8 Rejection of Claims under 35 U.S.C. § 103

9 Claims 21-24, 27, 29 and 31-32 stand rejected under 35 U.S.C. § 103(a) as
10 being unpatentable over U.S. Patent No. 5,898,823 ("Sorkin"), in view of U.S. Patent
11 No. 6,728,012 ("Bacher"). Claim 28 stands rejected under 35 U.S.C. § 103(a) as
12 being unpatentable over Sorkin and Bacher, in view of "Official Notice". Claims 14,
13 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over
14 Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official
15 Notice". Claims 26 and 30 stand rejected under 35 U.S.C. § 103(a) as being
16 unpatentable over Sorkin and Bacher, in view of U.S. Patent No. 6,219,151
17 ("Manglapus"). Claims 15, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as
18 being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific
19 MIB, in view of "Official Notice as applied to claims 14 and 16, and in further view of
20 Bacher. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable
21 over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official
22 Notice" as applied to claims 14 and 16 above, and in further view of Manglapus.
23 Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over
24 Sorkin, Bacher and Laser Jet Series 4050 Printer Model Specific MIB, in view of
25 "Official Notice".

Claims 23 and 25 have been cancelled as indicated above. Thus, the
respective § 103 rejections of claims 23 and 25 are now moot.

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1 Claim 15 depends from claim 14, as amended. Claims 17-20 depend, directly
2 or indirectly, from claim 16, as amended. Claims 22, 24 and 26-32, as respectively
3 amended, depend from claim 21, as amended. It is axiomatic that any claim
4 depending (directly or indirectly) from an allowable base claim is also allowable. For
5 this reason, the Applicants focus the following arguments in favor of allowability on
6 independent claims 14, 16 and 21, as respectively amended. The Applicants do not
7 believe it necessary to present arguments in favor of each and every dependent
8 claim in order to demonstrate their respective allowabilities.

9 As a starting point, MPEP 706.02(j) states:

10 "[t]o establish a *prima facie* case of obviousness, three basic
11 criteria must be met. First, there must be some suggestion or
12 motivation, either in the cited references themselves or in the
13 knowledge generally available to one of ordinary skill in the art, to
14 modify the reference or to combine the reference teachings. Second,
15 there must be a reasonable expectation of success. Finally, the prior
16 art reference (or references when combined) must teach or
17 suggest all the claim limitations. The teaching or suggestion to
18 make the claimed combination and the reasonable expectation of
19 success must both be found in the prior art and not based on
20 applicant's disclosure." (Emphasis added.)

21
22 Claim 14

23 The Applicants assert that claim 14, as amended, and claim 15 that depends
24 therefrom, are allowable. In regard to claim 14, as amended, the claim recites the
25 following features and limitations:

 A method for a client to discover a peripheral address, by way of
 a peripheral server, the method comprising:

1 sending a first message to the peripheral server, wherein the
2 first message contains an address of the client, and wherein the first
3 message is formatted as a print job that contains a Peripheral
4 Management Language (PML) object, and wherein the PML object is
5 UI_SELECT_OPTION, and wherein the print job includes no content
6 resulting in a printed output; and

7 receiving at the client a second message containing the
8 peripheral address.

9 (Emphasis added).

10
11 Sorkin fails to teach or suggest sending a first message to the peripheral
12 server, wherein the first message contains an address of the client, and wherein the
13 first message is formatted as a print job that contains a Peripheral Management
14 Language (PML) object, and wherein the PML object is UI_SELECT_OPTION, as
15 recited in combination with the other feature and limitations of claim 14, as
16 amended. In fact, the Examiner has admitted that Sorkin is specifically lacking the
17 PML object UI_SELECT_OPTION, or any suggestion or teaching directed thereto
18 (page 8 of Office Action).

19 Sorkin is directed to establishing direct communication between a client
20 computer 14 and a networked printer 24 by way of *SNMP traps* (Col. 2, lines 3-50 of
21 Sorkin). Sorkin fails to teach or suggest, in any context, the use of *any* PML object,
22 and Sorkin completely fails to teach or suggest use of the specific PML object
23 UI_SELECT_OPTION.

24 The Laser Jet Series 4050 Printer Model Specific MIB (hereinafter, the 4050
25 MIB) fails to cure the deficiency of Sorkin. Specifically, the 4050 MIB fails to teach
or suggest the particular PML object UI_SELECT_OPTION, as recited in
combination with the other features and limitations of claim 14, as amended. The

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1 Examiner has acknowledged this deficiency on the part of the 4050 MIB (page 9 of
2 Office Action). However, the Examiner states at Para. 27 of the Office action:

3 "Although, The Laser Jet Series 4050 Printer Model Specific
4 MIB taught wherein the PML object is HELD_JOB_DELETE, however,
5 Sorkin and The Laser Jet Series 4050 Printer Model Specific MIB did
6 not specifically teach wherein the PML object is UI_SELECT_OPTION.

7 "Official Notice" is taken for the concept of using different type of PML
8 object is known and accepted in the art. It would have been obvious to
9 one having ordinary skill in the art at the time of the invention was
10 made to include different types of PML objects because by doing so it
11 would increase the field of use in their systems."

12
13 Respectfully, the Applicants contest this assertion that general knowledge in
14 the art of a "HELD_JOB_DELETE" PML renders use of the "UI_SELECT_OPTION"
15 PML of claim 14 obvious. Firstly, the Examiner has failed to demonstrate that, at the
16 time of the present invention, one of ordinary skill in the art would have been aware
17 that the PML object "UI_SELECT_OPTION" even existed, let alone that such an
18 artisan would find it obvious to apply that particular PML object in any way even
19 remotely similar to that as recited by instant claim 14, as amended. Second of all,
20 the mere existence of one PML does not render the existence of a second PML
21 obvious, and moreover, the particular use of a first PML does not render the use of a
22 second PML obvious for an entirely different purpose! There cannot be anything
23 obvious about that which is unknown.

24 In accordance with MPEP 2144.03(C), the Applicants respectfully request that
25 the Examiner provide evidence in support of "Official Notice" as taken with respect to
demonstrating that one of ordinary skill in the art, at the time of the present

1 invention, was aware of the PML object UI_SELECT_OPTION, and how to apply
2 that PML object as recited by claim 14, as amended.

3 In summary, the Examiner has failed to show that any of the cited references
4 provide, teach or suggest the PML object UI_SELECT_OPTION, let alone that one
5 having ordinary skill in the art at the time the invention was made would find it
6 obvious to apply that PML object in any way even remotely similar to that as recited
7 by instant claim 14, as amended. In view of the foregoing deficiencies, and in further
8 view of the requirements as recited by MPEP 706.02(j), the Applicants assert that
9 the § 103 rejection of claim 14, as amended, is unsupportable and should be
10 withdrawn.

11 For at least these reasons, the Applicants assert that claim 14, as amended,
12 is allowable. As claim 15 depends from claim 14, as amended, it is axiomatic that
13 claim 15 is also allowable.

14

15 Claim 16

16 The Applicants assert that claim 16, as amended, and claims 17-20 that
17 depend (directly or indirectly) therefrom, are allowable. In regard to claim 16, as
18 amended, the claim recites the following features and limitations:

19

20 An apparatus comprising:

21 a client computer;

22 a peripheral server, connected to the client computer, wherein
23 the peripheral server receives a first message from the client
24 computer, the first message containing an address of the client
25 computer; and

1 a peripheral, connected to the peripheral server, wherein the
2 peripheral receives the first message from the peripheral server and
3 notifies the client computer of the peripheral's address, wherein:

4 the first message is formatted as a print job, the print job
5 including no content resulting in a printed output, and wherein
6 the print job contains a Peripheral Management Language
7 (PML) object, and wherein the PML object is
8 UI SELECT OPTION;

9 the peripheral includes at least one non-printer function;
10 and

11 the client computer is configured to access the at least
12 one non-printer function of the peripheral using the peripheral's
13 address and without using the peripheral server.

14 (Emphasis added.)

15
16 Sorkin fails to teach or suggest a print job [that] contains a Peripheral
17 Management Language (PML) object, and wherein the PML object is
18 UI SELECT OPTION, as recited in combination with the other features and
19 limitations of claim 16, as amended. The 4050 MIB fails to cure the deficiency of
20 Sorkin. In particular, the 4050 MIB fails to teach or suggest a print job [that] contains
21 a Peripheral Management Language (PML) object, and wherein the PML object is
22 UI SELECT OPTION, as recited in combination with the other features and
23 limitations of claim 16, as amended. The Applicants respectfully reiterate their
24 request under MPEP 2144.03(C) as stated above for provision of evidence in
25 support of "Official Notice" as taken by the Examiner in regard to the PML object
 UI_SELECT_OPTION. In view of the deficiencies described above, the Applicants
 assert that the § 103 rejection of claim 16, as amended, is unsupportable in view of

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1 MPEP 706.02(j) and should be withdrawn.

2 For at least these reasons, the Applicants assert that claim 16, as amended,
3 is allowable. As claims 17-20 depend (directly or indirectly) from claim 16, as
4 amended, it is axiomatic that claims 17-20 are also allowable.

5

6 Claim 21

7 The Applicants assert that claim 21, as amended, and claims 22, 24 and
8 26-32 (as respectively amended) that depend therefrom, are allowable. In regard to
9 claim 21, as amended, the claim recites the following features and limitations:

10

11 A method for communication between networked devices, the
12 method comprising:

13 sending a first message from a client to a peripheral server by
14 way of a network, the first message including a network address of the
15 client, and wherein the first message is formatted as a print job
16 containing a Peripheral Management Language (PML) object, and
17 wherein the PML object UI SELECT OPTION;

18 sending the first message from the peripheral server to a
19 multifunction peripheral by way of the network;

20 sending a second message from the multifunction peripheral to
21 the client by way of the network, the second message including a
22 network address of the multifunction peripheral; and

23 accessing a non-printer function of the multifunction peripheral
24 by way of the network using the client and the network address of the
25 multifunction peripheral and without using the peripheral server.

(Emphasis added.)

1 Sorkin fails to teach or suggest a first message is formatted as a print job
2 containing a Peripheral Management Language (PML) object, and wherein the PML
3 object UI SELECT OPTION, as recited in combination with the other features and
4 limitations of claim 21, as amended. Again, Sorkin is directed to establishing
5 communication by way of SNMP traps. This is not the same as the invention as
6 recited by claim 21, as amended.

7 Bacher fails to cure the deficiencies of Sorkin. Specifically, Bacher fails to
8 teach or suggest a first message is formatted as a print job containing a Peripheral
9 Management Language (PML) object, and wherein the PML object
10 UI SELECT OPTION, as recited in combination with the other features and
11 limitations of claim 21, as amended.

12 Rather, Bacher is directed to a multifunction terminal wherein an arrangement
13 of feeding stations 12, 14, intermediate storing trays 62, 63, and feeding members
14 77 are cooperatively disposed with respect to a printer 51, a data reader 55, etc.,
15 along a feeding path 18 (Abstract; Fig. 1 of Bacher). In short, Bacher is directed to a
16 particular arrangement of sheet media handling parts and sub-systems within a
17 multifunctional device. Bacher provides no teaching or suggestion whatsoever in
18 regard to sending the first message from the peripheral server to a multifunction
19 peripheral by way of the network, sending a second message from the multifunction
20 peripheral to the client by way of the network, the second message including a
21 network address of the multifunction peripheral, and then accessing a non-printer
22 function of the multifunction peripheral by way of the network using the client and the
23 network address of the multifunction peripheral and without using the peripheral
24 server, as recited in combination with the other features and limitations of claim 21,
25 as amended. Bacher does not teach or suggest use of any PML object, in any way.

There is no way to combine elements selected from Sorkin, and then to somehow combine those elements with other elements selected from Bacher, in

1 order to arrive at the invention as recited by claim 21, as amended, as no possible
2 combination of Sorkin with Bacher teaches or suggests all of the necessary
3 limitations. This deficiency renders the § 103 rejection of claim 21, as amended,
4 unsupportable in view of the requirements of MPEP 706.02(j). The fact is, none of
5 the references cited thus far in the case record provide, teach or suggest the PML
6 object UI_SELECT_OPTION of claim 21.

7 For at least these reasons, the Applicants assert that claim 21, as amended,
8 is allowable. As claims 22, 24 and 26-32 (as respectively amended) depend from
9 claim 21, as amended, it is axiomatic that claims 22, 24 and 26-32, as respectively
10 amended, are also allowable.

11

12 Rejection of Claims under Non-Statutory Double Patenting

13 Claim 14 is rejected under the judicially created doctrine of obviousness-type
14 double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No.
15 6,559,965 ("Simpson et al.") (pages 2-3 of Office Action).

16 In light of the fact that the claim 14 has been amended, the Applicants
17 respectfully request reconsideration of the obviousness-type double patenting of this
18 claim in light of the amendments.

19

20 Status of Instant Application

21 The Examiner's statement that the instant application is currently pending as
22 a result of a request for a Continued Prosecution Application (CPA), as filed on
23 12/27/04 in accordance with 37 CFR 1.53(d), is not correct (page 2 of Office Action).

24 In fact, the instant application is currently pending as a result of a Request for
25 Continued Examination in accordance with 37 CFR 1.114, as deposited with the
United States Postal Service as First Class mail on December 20, 2004. The
Examiner is respectfully referred to that submission to the Office.

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Summary

The Applicants believe that this response constitutes a full and complete response to the Office Action dated February 16, 2005. Therefore, the Applicants respectfully request examination on the merits of claims 14-22, 24, and 26-32, as respectively amended, in favor of timely allowance.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

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